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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,887	01/07/2002	James D. Jacobson	EIP-5784 (1417GP657)	8858

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EXAMINER

HAN, MARK K

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 11/26/2003

121

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,887

Applicant(s)

JACOBSON ET AL.

Examiner

Mark K Han

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 24-29, 32-44, 46, 51-53, 56, 60, 61 and 68-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23, 30, 31, 45, 47-50, 54, 55, 57-59 and 62-67 is/are rejected.
- 7) ☒ Claim(s) 6-10, 57-59, 62 and 65-67 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 6 and 8. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species I (claims 1-23, 30, 31, 45, 47-50, 54, 55, 57-59 and 62-67) in Paper No. 10 is acknowledged.
2. Claims 24-29, 32-44, 46, 51-53, 56, 60, 61 and 68-73 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11.

Claim Objections

3. Claims 6-10, 57-59, 62 and 65-67 are objected to because of the following informalities: It is the Examiner's position that Applicant has evoked 35 U.S.C. 112, 6th paragraph, means-plus-function language to define Applicant's invention. Therefore, the Examiner has objected to the claims for the reasons set forth above in the objection to the specification.

Appropriate correction is required.

Specification

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4. The disclosure is objected to because of the following informalities: It is the Examiner's position that Applicant has evoked 35 U.S.C. 112, 6th paragraph, means-plus-function language to define Applicant's invention. Therefore, the Examiner requires the Applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials and acts perform the function recited in the claim element. Please note that the MPEP clearly states, "Even if the disclosure implicitly sets for the structure, materials, or acts corresponding to the means- (or step-) plus-function claim element in compliance with 35 U.S.C. 11, 1st and 2nd paragraphs, the PTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o)..." (Also see MPEP 2181 [Rev. 1, February 2000])

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4-19, 21-23, 30, 31, 45, 47-50, 54, 55, 57-59, 62-64, 66 and 67 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,630,799 to Beiser et al. (hereinafter "Beiser").

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Beiser discloses an infusion system having a length of tube 2, controller 5, flow valve 101a, pressure sensor 257, memory (col. 4, line 53-54), display 5b, network communication 13, power source (col. 7, lines 33-34) and pump 4. See Figures 1, 2 and 16. See also cols. 1-2. In reference to claim 54, it is considered that calibration of sensor equipment to be inherent in the disclosure of Beiser.

6. Claims 1-14, 48-50, 54 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,803,626 to Bachman et al. (hereinafter "Bachman").

Bachman discloses a system for delivering fluid having a tube (unnumbered), control 32, flow sensor 22, flow valve 29, pressure sensor 24, memory (col. 6, line 50 – col. 7, line 47), display 30, processor 100 (means for network communication), power source (unnumbered) and pump (col. 1, lines 35-39). See Figures 1-10. See also cols. 1-3 and col. 7, lines 22-47.

7. Claims 1-23, 30, 31, 45, 47-50, 54, 55, 57-59 and 62-67 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,998,914 to Wiest et al. (hereinafter "Wiest").

Wiest discloses an infusion set having a tube 9, controller 12, flow sensor 16, flow valve (see claim 11), pressure sensor 5, memory 22, display 12, means for network communication 20 and pump 4. See Figures 1-3.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark K Han whose telephone number is 703-308-4543. The examiner can normally be reached on Monday to Friday, 9 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Mark Han
Patent Examiner
Art Unit 3763

mkh
November 19, 2003



MICHAEL J. HAYES
PRIMARY EXAMINER